REMARKS

Reexamination and reconsideration of this application as amended is requested. By this amendment, Claims 1, 5, 6, 11, 15, 18, 21, 25, 28, 32, 33, and 38, have been amended. After this amendment, Claims 1-39 remain pending in this application.

Overview of the Present Invention

The present invention is directed to a system and method for user-specified error correction in an instant messaging system. The invention utilizes at least two client systems that are communicatively coupled to a **"messaging server system"** via a network. Page 4, lines 13-15 of the instant application. The messaging server system contains an instant message manager and **controls the flow of messages between the client systems**. Page 5, lines 1-3 of the instant application. Claims 1, 5, 6, 11, 15, 18, 25, 28, 32, 33, and 38, have been amended to more clearly and distinctly emphasize this feature. Claim 21 was amended only to correct a minor typo, and not for patentability or to further limit the claim in view of any prior art. No new matter was added by the amendments to the claims.

FIGs. 4-6 of the instant specification show the operational flow of the present invention, where message corrections can be made at a transmitting client device and routed to the messaging server. The messaging server then determines whether or not the message has been transmitted to the receiving client and either corrects the message before sending or forwards the corrections to the receiving client device if the message has already been sent. Pages 7-12. Finally, the receiving client device checks to see if the message is a correction and, if it is, retrieves the original message from the conversation log, corrects it, and alerts the user that a correction has been submitted.

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<u>Overview of the Svoboda Reference</u>

The Svoboda reference teaches a method and device for modification of a message in a communication system. The focus of Svoboda is on a password that contains information regarding the identity of a sender of a message and works "as a key for obtaining an access to functions of modification and/or deleting a message having been stored." *See* claim 1 of Svoboda.

Svoboda discloses a transmission unit and a receiver unit coupled through a network, such as the internet. Svoboda, col. 2, lines 53-63. Each of the transmission unit and the receiver unit are "connected to a storage unit, e.g. a mail server." Svoboda, col. 2, lines 56-57. Importantly, Svoboda does not discuss any purpose of the "mail server" other than as merely a storage space. Therefore, the mail server of Svoboda does not have functionality for message correction or replacement as does the routing server of the present invention. In Svoboda, the editing or deleting of a message occurs at the receiver unit of a destination email server. In short, **Svoboda does not teach or explain an instant messaging server or its functions <u>that sends to a recipient client system</u> the message correction specification or the corrected message as claimed for the present invention.** Note that the Svoboda destination email server is distinguishable from a recipient client system as recited for the presently claimed invention. Further, the editing (e.g., correction) in Svoboda is done at the destination email server. On the other hand, the correction of an instant message, according to the present invention, is done prior to sending the corrected message or the message correction specification to the recipient client system.

Claim Rejections - under 35 USC § 102 Svoboda

The Examiner rejected Claims 1-9, 11, 13, 14, 28-36, 38, and 39 under 35 U.S.C. 102(e) as being anticipated by Svoboda (U.S. Patent No. 6,597,771).

<u>Claims 1 and 28</u>:

Applicants have amended Claim 1 to more clearly and distinctly recite the present invention. Support for this amendment may be found in the specification as originally filed, see for example from page 5, lines 1-3. No new matter was added.

Before further discussing the Svoboda reference, it is believed that a brief review of amended claim 1 would be helpful. Claim 1 states, *inter alia*:

> accepting a correction to a previously sent message;
> determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification; and
> based on the determination of message correction of the previously sent message, **sending to an instant message manager on a messaging server** one of a complete corrected message and a message correction specification. (emphasis added)

The Examiner states that Svoboda anticipates claim 1 and cites, on pages 2 and 3 of the Office Action, col. 1, lines 57-67 of Svoboda. The cited portion of Svoboda states: "*after receiving **a message**, the message **being delivered into a receiver communication unit** through data communication means **and stored in a storage unit**, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message **stored in a communication unit of the receiver.**" (emphasis added) All of the message

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editing functionality of Svoboda and all of the language quoted by the Examiner is describing functions performed at the *receiving* client device.

Claim 1 has been amended to clarify that a message correction instruction is sent to an instant messaging manager on a message server. In contrast to Svoboda, claim 1 of the instant application is directed to functions performed on a *transmitting* client device. For this reason, Svoboda is completely silent on "*determining* whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification" and then "*based on the determination* of message correction of the previously sent message, *sending to an instant messaging manager on a messaging server* one of a complete corrected message and a message correction specification."

Claim 28 contains the same method steps as does claim 1, as originally filed. However, the method steps in claim 28 are in the form of instructions on a computer readable medium. As stated above, Svoboda discusses only functions occurring on the receiving client device. Therefore, Svoboda is completely silent on "a computer readable medium comprising computer instructions for determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification," which is a step that occurs on a sending device and not a receiving device.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.[1] Because the elements in independent claims 1 and 28 (at

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[1] See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,

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least *"sending to an instant messaging manager on a messaging server"* and *"computer instructions for determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification"*) of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1 or claim 28. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome with respect to amended independent claims 1 and 28, and all dependent claims depending therefrom, respectively.

Claims 5 and 32:

Amended independent claims 5 and 32 recite, *inter alia*:

receiving, at an instant messaging manager on a messaging server, a message correction specification and a message identifier (ID) from an originating client system; and
sending the message correction specification and the message ID to a recipient client system if a message with a corresponding message ID has previously been sent to the recipient client system.

Claims 5 and 32 recite receiving a message from an originating client system and then checking a message ID before sending to a recipient client system. This operation is a step that is performed on a device **between** the message originating sending device and the message recipient client device.

Svoboda is completely silent on an instant messaging manager on a messaging server or any other similar device and, as a result, silent on functionality within a device (such as a messaging server) located between the

1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

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message originating sending device and the message recipient device.
Therefore, Svoboda does not disclose a server device that checks whether "*a message with a corresponding message ID has previously been sent to the recipient client system*" before "*sending the message correction specification and the message ID to a recipient client system,*" as recited for claims 5 and 32 of the instant application.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a <u>single reference teach</u> (i.e., identically describe) each and every element of the rejected claims.[1] Because the elements in independent claims 5 and 32 (at least "*receiving a message correction specification and ...sending the message correction specification...to a recipient client system if a message with a corresponding message ID has previously been sent...*") of the instant application are <u>not</u> taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 5 or claim 32. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome with respect to all of these claims.

<u>Claims 6 and 33</u>:

With regard to independent claims 6 and 33 of the instant application, claims 6 and 33 recite, *inter alia*:

> receiving, at an instant messaging manager on a messaging server, a message correction specification and a message identifier (ID) from an originating client system;
> correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system; and
> sending the corrected message and the message ID to a recipient client system.

The Examiner, on pages 2 and 3 of the Office Action, cites col. 1, lines 57-67 of Svoboda, which states "*after receiving a message, the message being delivered into a receiver communication unit through data communication means and stored in a storage unit, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message stored in a communication unit of the receiver.*" (emphasis added) All of the message-editing function of Svoboda and all of the language quoted by the Examiner is describing functions performed at the *receiving* email server.

Svoboda is completely silent on any message editing operations prior to the message being delivered to the receiving client device. Therefore, Svoboda could not, and does not, disclose checking whether a message has "*previously been sent to a recipient client system*" and "*correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system.*" Furthermore, because the message is already residing in a storage space at the receiving email server in Svoboda, Svoboda does not disclose the resulting step of "*sending the corrected message and the message ID to a recipient client system,*" as recited in claims 6 and 33.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.[1] Because the elements in independent claims 6 and 33 (at least "*sending the corrected message and the message ID to a recipient client system*") of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent

claims are believed to be patentable as well because they all are ultimately dependent on either claim 6 or claim 33. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome with respect to all of these claims.

<u>Claims 9 and 36</u>:

Independent claims 9 and 36 recite, *inter alia*:

> maintaining an ephemeral storage log of an instant messaging conversation;
> receiving a message correction specification and a message identifier (ID) from an originating client system;
> determining if a message processing service is required;
> correcting a message with a corresponding message ID in the ephemeral storage log if a message processing service is required; and
> sending the corrected message and the message ID to a recipient client system.

As stated above, all of the message-editing functionality of Svoboda and all of the language quoted by the Examiner on pages 2 and 3 of the Office Action is describing functions performed at the *receiving* email server.

The steps recited in claims 9 and 36 describe correcting a message *prior to* sending it to the recipient client system. Therefore, Svoboda is completely silent on: *maintaining an ephemeral storage log of an instant messaging conversation; receiving a message correction specification and a message identifier (ID) from an originating client system; determining if a message processing service is required; and correcting a message with a corresponding message ID in the ephemeral storage log if a message processing service is required* **before** *sending the corrected message and the message ID to a recipient client system*, as recited in claims 9 and 36 of the instant application.

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The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a <u>single reference teach</u> (i.e., identically describe) each and every element of the rejected claims.[1] Because the elements in independent claims 9 and 36 of the instant application are <u>not</u> taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 9 or claim 36. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome with respect to all of these claims.

<u>Claims 11 and 38</u>:

Independent claims 11 and 38 recite, *inter alia*:

> receiving a message correction specification and a message identifier (ID) from an instant messaging manager on a messaging server;
> retrieving a message with a corresponding message ID from a conversation log;
> correcting the message;
> updating the conversation log; and
> activating an alert to notify a user of an update.

Svoboda discloses messages that are sent to a receiving email server device and then deposited in a storage unit. Svoboda, col. 2, lines 50-62. The invention of Svoboda allows a user of the sending device to cause the message in the storage unit to be edited or deleted. Svoboda, col. 2, lines 24-31, lines 56-57, and lines 60-62. Importantly, however, Svoboda is completely silent on "*activating an alert to notify a user of an update.*" In fact, Svoboda specifically states that the "invention allows the sender to change or delete the message **without bothering the addressee** with an invalid message." Svoboda, col. 2, lines 31-33. Therefore, Svoboda actually *teaches away* from "activating an alert to notify a user of an update," as recited in claims 11 and 38 of the instant

application.

Additionally, Svoboda is silent on a "conversion log" and is therefore silent on the step of "*updating a conversion log*," as recited in claims 11 and 38 of the instant application.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a <u>single reference teach</u> (i.e., identically describe) each and every element of the rejected claims.[1] Because the elements in independent claims 11 and 38 of the instant application are <u>not</u> taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 11 or claim 38. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicants respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome with respect to these claims.

Claim Rejections - 35 USC § 103 Svoboda

The Examiner rejected Claims 10 and 37 under 35 U.S.C. 103(a) as being unpatentable over Svoboda (U.S. Patent No. 6,597,771).

In the section entitled "Rejection under 35 U.S.C. § 102 Svoboda" above, the deficiencies of the prior-art system disclosed in the Svoboda reference were discussed. Claims 10 and 37 depend directly from claims 9 and 36, respectively. As discussed above, independent claims 9 and 36 distinguish over Svoboda. Since dependent claims contain all the limitations of the independent claims, claims 10 and 37 distinguishes over Svoboda, as well.

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Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Svoboda reference applied in the rejection of claims 10 and 37, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Svoboda reference, as required by MPEP § 2143. The Applicants respectfully request that the Examiner's rejection of claims 10 and 37 be withdrawn.

Claim Rejections - 35 USC § 103 Maurille in view of Svoboda

The Examiner rejected Claims 10 and 37 under 35 U.S.C. 103(a) as being unpatentable over Maurille (U.S. Patent No. 6,484,196) in view of Svoboda (U.S. Patent No. 6,597,771).

Before discussing the prior art in detail, it is believed that a brief review of the present invention would be helpful. Amended Claim 15 recites, *inter alia*:

...

> **an error corrector**, communicatively coupled to the instant messaging client, for accepting a correction to a previously sent message, determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification, and **based on the determination** of message correction of the previously sent message, **sending to an instant messaging manager on a messaging server** one of a complete corrected message and a message correction specification being destined for reception by another instant messaging client.

Claim 15 recites "an error corrector." The Examiner, on page 4 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message." Therefore Maurill does not teach or suggest an error corrector as recited in claim 15. The Examiner goes on to combine Svoboda.

On pages 4 of the Office Action, The Examiner cites col. 1, lines 57-67 of Svoboda, which states "*after receiving a message, the message being*

delivered into a receiver communication unit through data communication means *and stored in a storage unit*, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message stored in a communication unit of the receiver." (emphasis added) All of the message-editing functionality of Svoboda and all of the language quoted by the Examiner is describing functions performed at the *receiving* destination device.

Svoboda is completely silent on any message editing operations prior to the message being delivered to the receiving destination device. Therefore, Svoboda could not, and does not, disclose any determining steps taken in the sending client device. Svoboda does not discuss how error correction is made at the sending client device. Therefore, Svoboda is completely silent on an *"error corrector"* and on *"determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification,"* as recited for claim 15 of the instant application.

Because Svoboda teaches editing at a receiving device, Svoboda actually *teaches away* from editing at the sending client device. Prior art that teaches away is a per se demonstration of lack of prima facie obviousness.[2]

As a result, Svoboda does not teach or suggest *"determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification, and based*

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[2] See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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on the determination of message correction of the previously sent message,
sending to an **instant messaging manager** on *a messaging server* one of a
complete corrected message and a message correction specification," as recited
in claim 15 of the instant application.

Claim 21:

Independent claim 21 recites, *inter alia*:

an error corrector, communicatively coupled to the instant
message manager, for receiving a message correction specification
and a message identifier (ID) from an originating client system,
correcting a message with a corresponding message ID if a
message with a corresponding message ID has not previously
been sent to a recipient client system, and sending the corrected
message and the message ID to a recipient client system.

Claim 21 recites "an error corrector." The Examiner, on page 4 of the
Office Action states that "Maurille does not show accepting a correction to a
previously sent message." Therefore Maurill does not teach or suggest an error
corrector as recited in claim 21. The Examiner goes on to combine Svoboda.

As stated above, Svoboda discloses all error correcting function occurring
at the **receiving** client device side. Claim 21 however, recites a step of
"*correcting a message... and* [then] *sending the corrected message and the
message ID to a recipient client system.*" Therefore, Svoboda does not teach or
suggest that recited in claim 21 of the instant application.

Claim 24 depends from claim 21 and is therefore believed to be
patentable for at least the same reason.

Claim 25:

Claim 25 recites, *inter alia*:

an instant messaging manager on a messaging server, communicatively coupled to the at least one originating client system, for receiving a message correction specification and a message identifier (ID) from the at least one originating client system, correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system, and sending the corrected message and the message ID to the recipient client system

The Examiner, on page 4 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message." As stated above, Svoboda does not teach or suggest a messaging server that is able to "correct[ ] a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system, and sending the corrected message and the message ID to the recipient client system."

Accordingly, in view of the amendments and remarks above, since neither Maurille or Svoboda alone, nor any combination of the two cited references, teaches, anticipates, or suggests, the presently claimed invention, Applicant believes that the rejection of claims 15, 21, 24, and 25 under 35 U.S.C. 103(a) has been overcome. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 15, 21, 24, and 25. The Examiner should withdraw the rejection of these claims.

Claim Rejections - 35 USC § 103 Maurille in view of Lewis

The Examiner rejected Claims 12 and 39 under 35 U.S.C. 103(a) as being unpatentable over Svoboda (U.S. Patent No. 6,597,771) in view of Lewis et al. (U.S. Patent No. 6,611,802)

In the section entitled "Rejection under 35 U.S.C. § 102 Svoboda" above, the deficiencies of the prior-art system disclosed in the Svoboda reference were discussed. Claims 12 and 39 depend directly from claims 11 and 38,

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respectively. As discussed above, independent claims 11 and 38 distinguish over Svoboda. Since dependent claims contain all the limitations of the independent claims, claims 12 and 39 distinguish over Svoboda, as well. The Lewis reference was combined by the Examiner to arguably obviate the feature of displaying highlighted corrected text. However, it is clear that Lewis does not teach or suggest the presently claimed invention, and further the combination of Svoboda and Lewis also does not teach or suggest the presently claimed invention.

Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Svoboda reference applied in the rejection of claims 12 and 39, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Svoboda reference by combining Lewis et al., as required by MPEP § 2143. The Applicants respectfully request that the Examiner's rejection of claims 12 and 39 be withdrawn.

Conclusion

The foregoing is submitted as full and complete response to the Official Action mailed March 23, 2005, and it is submitted that Claims 1-39 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1-39 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicants acknowledge the continuing duty of candor and good faith to disclose information known to be material to the examination of this application.

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In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and the attorneys.

Additionally, a petition for a two month extension of time to file this Response has been attached to this Response. The Commissioner is hereby authorized to charge the extension fee for response of ($450), or if this fee amount is insufficient, then the Commissioner is authorized to charge the appropriate fee amount to prevent this application from becoming abandoned, to Deposit Account 50-1556.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 50-1556.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: 8/23/2005

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